

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

FEB 28 1996

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

PAT.&T.M. OFFICE
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AND INTERFERENCES

Ex parte FREDERICK T. LIN

Appeal No. 94-0573
Application 07/749,958¹

ON BRIEF

Before MEROS, LYDDANE and STAAB, Administrative Patent Judges.
MEROS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the examiner's rejection of claims 7-25, all of the claims pending in the application.

Claims 17-22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for being dependent on a rejected claim, i.e., canceled "claim 1." This rejection constitutes a new ground of rejection introduced in the

¹ Application for patent filed August 26, 1991.

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Examiner's Answer. Appellant was properly informed (Answer, page 9) that failure to respond to this new ground of rejection would result in dismissal of the appeal of the claims so rejected. Since appellant has not responded to this rejection, the appeal is dismissed as to claims 17-22.²

The rejected claims are directed to a ray-shield that is attachable to a glass surface. The ray-shield comprises a thin sheet having a plurality of apertures positioned around at least a portion of its periphery, suction cups having a stem which passes through said apertures, and resilient securing means which grips said stem and secures the suction cups to the ray-shield sheet.

Claim 7, the sole independent claim, is illustrative of the claimed subject matter and reads as follows:

7. A ray-shield for releasably attaching to a glass surface comprising:

a thin sheet of ray-shield material having a front surface for placement adjacent to the inner surface of said glass surface and a back surface on the side opposite to said inner surface;

a plurality of spaced apart apertures positioned around at least a portion of the periphery of said thin sheet of ray-shield material, said apertures spaced from the edges of said thin sheet of ray-shield material toward each other;

² In a telephone call to the office of appellant's attorney on July 27, 1995 by the Board Administrator, verification that no reply brief was filed or would be filed was given. We, therefore, see no reason for remanding the case to the examiner to address the issue.

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suction cups equal in number to said apertures for securing said thin sheet of ray-shield material to said glass surface comprising an integrally formed resilient cup and stem portion, said stems are formed as an integral extension of said cup, said stem passes through said apertures from said inner surface and terminate slightly beyond said back surface, and said stems having a close fit in said apertures; and

resilient securing means for frictionally gripping of said stem after passing said stem through one of said plurality of apertures thereby securing said suction cup to said thin sheet of ray-shield material.

The examiner relies on the following references:

| | | |
|---------|-----------|---------------|
| Zip | 3,649,069 | Mar. 14, 1972 |
| Eubanks | 4,736,980 | Apr. 12, 1988 |

Claims 7-16 and 23-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eubanks in view of Zip. We will not sustain the rejection.

The windshield shade disclosed by Eubanks, the primary reference, is attached to a windshield on one side by means of two suction cups attached to the housing from which the shade is pulled to unroll it and on the other side by means of a pull member having a keyhole opening which attaches to a button having a neck attached to a pair of suction cups that are attached to the windshield.

Zip discloses a glare shield for an automobile window which comprises a series of planar, segmentally shaped vanes radially extending from a centrally located structure comprising a suction cup which secures the glare shield to the surface of the window.

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The examiner urges that it would have been obvious to substitute the suction cup structure disclosed by Zip for that of the windshield shade disclosed by Eubanks.

Initially, the examiner has failed to set forth cogent and convincing reasoning establishing the requisite motivation which would have led the ordinarily skilled artisan to substitute the particular suction cup structure disclosed by Zip for that employed by Eubanks.

Moreover, even assuming that the ordinarily skilled artisan would have somehow been motivated to replace the suction cup structure of Eubanks with the particular suction cup structure disclosed by Zip, which we believe makes little sense, the resulting windshield shade would not be that here claimed, i.e., a shade comprising a thin sheet having a plurality of spaced apart apertures around at least a portion of its periphery, suction cups having a stem which passes through said apertures, and resilient securing means that secure the suction cups directly to the shade sheet.

Thus, it is clear that the examiner has failed to establish prima facie obviousness of the claimed invention as a whole. We are, therefore, constrained to reverse the examiner's rejection of claims 7-16 and 23-25 under 35 U.S.C. § 103.

Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite as to the meaning of "integrally

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formed resilient cup and stem." The examiner urges that it is not clear whether the parts are "integrally molded, integrally fitted, etc.."

Appellant argues that it is readily understood that "integrally formed resilient cup and stem" defines "a cup and stem formed together as one unit by and [sic] any convenient means..." (Brief, paragraph bridging pages 5 and 6). We agree. Moreover, the examiner seems to indicate agreement in the paragraph bridging pages 8 and 9 of his Answer. Accordingly, we reverse the above rejection of claim 7.

Claim 25 stands rejected under 35 U.S.C. § 112, first paragraph, as lacking support in the specification as to the ray-shield material being "sheet metal."

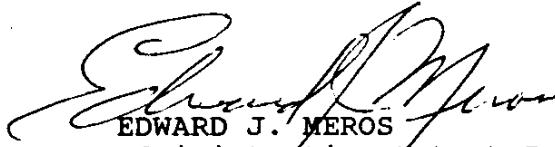
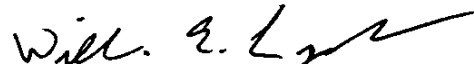
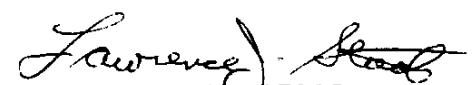
Appellant simply asserts that the subject matter of claim 25 is "clearly set out in the application as originally filed by applicant, see the abstract, specification and claims" (Brief, page 7). Appellant's assertion is simply wrong. We, therefore, affirm the above rejection of claim 25.

In summary, we have reversed the § 103 rejection of claims 7-16 and 23-25 and the § 112 rejection of claim 7, affirmed the § 112 rejection of claim 25, and dismissed the appeal as to claims 17-22.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART


EDWARD J. MEROS)
Administrative Patent Judge)

WILLIAM E. LYDDANE)
Administrative Patent Judge)

LAWRENCE J. STAAB)
Administrative Patent Judge)

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